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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/760,554 | 01/21/2004 | Tatsuya Usami | 029437-0103 | 8646 |

22428 7590 12/19/2005
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EXAMINER

WILLIAMS, ALEXANDER O

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2826

DATE MAILED: 12/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

H.D

| | | | |
|------------------------------|--|-------------------------------------|--|
| Office Action Summary | Application No. 10/760,554 | Applicant(s) USAMI ET AL. | |
| | Examiner Alexander O. Williams | Art Unit 2826 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3 to 16 is/are pending in the application.
- 4a) Of the above claim(s) 10-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>1/21/04</u> . | 6) <input type="checkbox"/> Other: _____ |

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Serial Number: 10/760554 Attorney's Docket #: 029437-0103

Filing Date: 1/21/2004; claimed foreign priority to 1/31/2003

Applicant: Usami et al.

Examiner: Alexander Williams

Applicant's election of the species of figure 9D (claims 1 and 3 to 9) has been acknowledged.

This application contains claims 10 to 16 drawn to an invention non-elected with traverse.

Claim 2 has been cancelled.

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

The disclosure is objected to because of the following informalities: Applicant's related application information should be updated.

Appropriate correction is required.

The use of the trademark L-OxTM or L-Ox[™] has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the a semiconductor substrate in claim 1 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New

Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claims 1 to 9 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, it is unclear and confusing to what is meant by and what shows "a semiconductor substrate." Where is this shown in the drawing?

In claim 6, as to the use of $L-Ox^{tm}$, although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Any of claims 1 to 9 not specifically addressed above are rejected as being dependent on one or more of the claims which have been specifically objected to above.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

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the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Initially, it is noted that the 35 U.S.C. § 103 rejection based on first and second insulating films deals with an issue (i.e., the integration of multiple pieces into one piece or conversely, using multiple pieces in replacing a single piece) that has been previously decided by the courts.

In Howard v. Detroit Stove Works 150 U.S. 164 (1893), the Court held, "it involves no invention to cast in one piece an article which has formerly been cast in two pieces and put together...."

In In re Larson 144 USPQ 347 (CCPA 1965), the term "integral" did not define over a multi-piece structure secured as a single unit. More importantly, the court went further and stated, "we are inclined to agree with the solicitor that the use of a one-piece construction instead of the [multi-piece] structure disclosed in Tuttle et al. would be merely a matter of obvious engineering choice" (bracketed material added). The court cited In re Fridolph for support.

In re Fridolph 135 USPQ 319 (CCPA 1962) deals with submitted affidavits relating to this issue. The underlying issue in In re Fridolph was related to the end result of making a multi-piece structure into a one-piece structure. Generally, favorable patentable weight was accorded if the one-piece structure yielded results not expected from the modification of the two-piece structure into a single piece structure.

Claims 1, 3 to 6, 8 and 9, **insofar as they can be understood**, is rejected under 35 U.S.C. § 103(a) as being unpatentable over Aoi et al. (U.S. Patent # 5,877,080).

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1. Aoi et al. (figures 1 to 3d) specifically figure 3d show a semiconductor device comprising: a semiconductor substrate **20**; a first insulating film **21** formed on an upper side of said semiconductor substrate, said first insulating film containing ladder-shaped siloxane hydride; and a second insulating film **21** disposed adjacent to said first insulating film, said second insulating film containing oxygen and silicon as constituent elements.

(30) For practical use, the ratio of phenyl silsesquioxane to the inorganic silica sol in the solution mixture is preferably 10 to 90 vol % in terms of SiO_2 . When the ratio of the inorganic sol is adjusted to be 50 vol % or more, the relative dielectric constant can be reduced significantly.

(31) Although the present example has used the ladder siloxane polymer having a phenyl group as the ladder siloxane polymer, a siloxane polymer having a hydrogen-silicon bond, or a siloxane polymer having an alkyl group such as a methyl group, a fluoroalkyl group, a cyclic alkyl group, a cyclic fluoroalkyl group, an aryl group such as a phenyl group, or a fluoroalkyl group may be used instead.

(56) Although the ladder siloxane polymer having a phenyl group has been used as the ladder siloxane polymer, a siloxane polymer having a hydrogen-silicon bond, or a siloxane polymer having an alkyl group such as a methyl group, a fluoroalkyl group, a cyclic alkyl group, a cyclic fluoroalkyl group, an aryl group such as a phenyl group, or a fluoroalkyl group may be used instead.

3. The semiconductor device according to claim 1, wherein said second insulating film comprises a compound selected from the group consisting of SiO_2 , SiOC , SiON and SiOF .

4. The semiconductor device according to claim 1, Aoi et al. further comprising a metal interconnect **24** embedded in a multilayer structure, said multilayer structure comprising said first insulating film and said second insulating film.

5. The semiconductor device according to claim 1, Aoi et al. show wherein said semiconductor device is free of a guard ring.

6. The semiconductor device according to claim 1, Aoi et al. show wherein said ladder-shaped siloxane hydride is L-Ox^m .

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As to claims 8 and 9, Note that the specification contains no disclosure of either the critical nature of the claimed dimensions or any unexpected results arising therefrom. Where patentability is said to be based upon particular chosen dimensions or upon another variable recited in a claim, the Applicant must show that the chosen dimensions are critical. In re Woodruff, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990).

Therefore, it would have been obvious to one of ordinary skill in the art to use the first and second insulating film the as "merely a matter of obvious engineering choice" as set forth in the above case law.

Initially, and with respect to claim 7, note that a "product by process" claim is directed to the product per se, no matter how actually made, In re Hiraio, 190 USPQ 15 at 17 (footnote 3). See also In re Brown, 173 USPQ 685; In re Luck, 177 USPQ 523; In re Wertheim, 191 USPQ 90 (209 USPQ 554 does not deal with this issue); In re Fitzgerald, 205 USPQ 594, 596 (CCPA); In re Marosi et al., 218 USPQ 289 (CAFC); and most recently, In re Thorpe et al., 227 USPQ 964 (CAFC, 1985) all of which make it clear that it is the final product per se which must be determined in a "product by process" claim, and not the patentability of the process, and that, as here, an old or obvious product produced by a new method is not patentable as a product, whether claimed in "product by process" claims or not. Note that Applicant has burden of proof in such cases as the above case law makes clear.

As to Claim 7, the grounds of rejection under section 103, see MPEP § 2113.


The listed references are cited as of interest to this application, but not applied at this time.

| Field of Search | Date |
|--|----------|
| U.S. Class and subclass: 257/758,760,762,751,753,761 | 12/11/05 |
| Other Documentation: foreign patents and literature in 257/758,760,762,751,753,761 | 12/11/05 |
| Electronic data base(s): U.S. Patents EAST | 12/11/05 |

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander O. Williams whose telephone number is (571) 272 1924. The examiner can normally be reached on M-F 6:30AM-7:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached on (571) 272 1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Alexander O Williams
Primary Examiner
Art Unit 2826

AOW
12/11/05